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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,345	09/25/2001	Tetsuo Nakata	1538.1017	5887

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,345

Applicant(s)

NAKATA ET AL.

Examiner

James S McClellan

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WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on February 26, 2004, wherein:
claims 1-49 are pending and
claims 1-49 have been amended.

Information Disclosure Statement

2. Applicant's submission of an Information Disclosure Statement (IDS) on April 20, 2004 is acknowledged. A signed copy of PTO-1449 included with the IDS is attached to this office action.

Claim Objections

3. Claim 32 is objected to because of the following informalities: in line 3, it is unclear what applicant means by "pf the receiver". The Examiner assumes that "pf" is merely a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. US 2002/0107820 (hereinafter "Huxter") in view of U.S. Patent Application No. US 2002/0072945 (hereinafter "Yang").

Regarding **claim 1**, Huxter discloses a method for processing physical distribution information, said method comprising the steps of: receiving and registering schedule information regarding a form of receiving of a package addressed to a member from the member (see page 5, paragraph #106); if a shipment request is received from a sender of a package, determining a delivery form with reference to at least the receiver's schedule information registered in said receiving and registering step if said receiver is a member (see page 5, paragraph #116); and if said delivery form determined in said determining step involves a movement of said package, generating delivery request information for a distributor in accordance with said delivery form (see page 5, paragraph #116); **[claim 2]** if said delivery form determined in said determining step involves a movement of the package, registering scheduled delivery information in said receiver's schedule information (see page 5, paragraph #116); **[claim 3]** sending said distributor information regarding said delivery form determined in said determining step before starting to deliver said package (see page 5, paragraph #11); **[claim 4]** receiving a delivery completion notice including receiving status data from said distributor (see page 2, paragraph #17); **[claim 5]** giving a predetermined point to said receiver if said receiving status data included in said delivery completion notice indicates the delivery has been performed by following a delivery schedule specified in said delivery form (see page 2, paragraph #17); **[claim 6]** giving a predetermined point to said receiver if said delivery form determined in said determining step

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indicates that delivery to a home of said receiver of said package and said receiving status data included in said delivery completion notice indicates that receiving has been performed by following a delivery schedule specified in said delivery form (see page 16, paragraph #255); **[claim 7]** receiving and registering information regarding a fixed delivery charge from said distributor after said package is received by said distributor (see page 15, paragraphs #245-246); **[claim 8]** there is a case where said delivery form is determined as undeliverable in said determining step (see page 16, paragraph #256); **[claim 9]** including information regarding a determined as undeliverable in said sending said sender a deliverable date if said delivery determining step (it is inherent that the e-tailer will be notified if a package is undeliverable); **[claim 10]** giving a predetermined point to said receiver if said delivery determined as forwarding or keeping in said determining step (see page 16, paragraph #255); **[claim 11]** said generating step, if said delivery form is determined as forwarding or keeping in said determining step, delivery request information addressed to said distributor is generated by using forwarding destination information or keeping place information registered for said receiver in advance (see page 16, paragraph #255); **[claim 12]** receiving and registering information of specified member from said member, and wherein, in said determining step, if said receiver is not available for receiving and said specified member is registered for said receiver, said schedule information for said specified member is referenced (see page 16, paragraph #255); **[claim 13]** if a delivery request to a non-member is received from a sender of a package, registering information of said non-member included in said delivery request as provisional member information; sending a member registration request to said non-member; and sending information registered as said provisional member information to said non-member if membership registration is requested

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from said nonmember (see page 7, paragraph #148); **[claim 14]** wherein in said receiving and registering step, schedule information regarding a form of receiving said package addressed to said member is received as a predetermined template selection instruction from said member (see page 5, paragraph #106); **[claim 15]** wherein said determining step comprises a step of sending a schedule input request to said receiver if said receiver's schedule information indicates it is not fixed (see page 16, paragraph #255); and **[claim 16]** wherein said determining step comprises a step of sending said sender a notice indicating scheduling in progress (see page 5, paragraph 106).

Regarding **claim 17**, Huxter discloses A method for processing physical distribution request, said method comprising the steps of: sending a central server (1000) a delivery request of a package, said delivery request specifying at least a receiver (400); and receiving a result notice of delivery scheduling including a case where it is indicated that said package is undeliverable, from said central server before starting to deliver said package (see page 16, paragraphs #255-256).

Huxter discloses a program and apparatus as set forth in **claims 18-49**. Claims 18-49 are similar to previously addressed claims 1-16.

Regarding claims 1, 17, 18, and 34, Huxter fails to disclose the schedule information comprising at least one of the forms of receiving the package addressed to the member for each of a plurality of days within a predetermined period.

Yang teaches method of package delivery and pickup including schedule information comprising at least one of the forms of receiving the package addressed to the member for each of a plurality of days within a predetermined period (see page 4, paragraphs 0060-0062).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huxter with schedule information related to a plurality of days as taught by Yang, because delivering items when the receiver is likely available to accept the items increases the efficiency of the delivery service, wherein decreasing the expense related to unsuccessful delivery attempts.

Response to Arguments

6. Applicant's arguments filed February 26, 2004 have been fully considered but they are not persuasive.

On pages 13-15, Applicant argues the 35 U.S.C. § 102 rejection of claims 1 and 17 in view of the Huxter publication. Applicant's arguments are moot, because applicant's amendment necessitated a new grounds of rejection including a secondary reference, Yang.

On page 15, final paragraph, Applicant argues that limitations in claim 6 are disclosed by Huxter. The limitation in claim 6 that Applicant relies upon to distinguish over the prior art includes a conditional limitation, "if", that is merely optional language. The M.P.E.P. section 2106 II C states, "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" In this case, the alternative to the challenged claim language is anticipated by Huxter. Applicant's argument on page 16 related to claim 9 is maintained for reasons similar to claim 6. Claim 9 includes conditional limitations that make the limitations optional.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

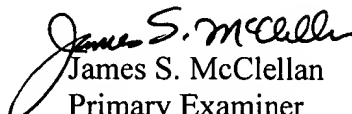
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(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
May 13, 2004